

REMARKS

Claims 1-2, 5, 9, 11-28 and 29-30 are pending. New claims 31-40 have been added and claim 30 has been amended. However, claims 1-2, 5, 9, and 11-28 are deemed withdrawn. Accordingly, claims 29-40 are being examined.

Amended claim 30 merely involves substitution of the article "the" with "a" and therefore does not involve any new matter.

Support for new claims 31-40 may be found in the claims and specification as originally filed. Accordingly, these changes do not involve new matter and Applicants respectfully request entry of these changes.

Support for new claim 31 may be found in the specification at page 11, lines 4-6; page 34, lines 5-7; and page 34, lines 18-19.

Support for new claim 32 may be found in the specification at page 25, lines 28-30; and Figure 3

Support for new claim 33 may be found in the specification at page 25, lines 28-31.

Support for new claim 34 may be found in the specification at page 34, lines 29-30; page 35, lines 1-2; and page 48, lines 9-10.

Support for new claim 35 may be found in the specification at page 48, lines 13-15.

Support for new claim 36 may be found in the specification at page 36, lines 6-8; and page 68, lines 9-10.

Support for new claim 37 may be found in the specification at page 34, lines 29-30.

Support for new claim 38 may be found in the specification at page 34, lines 21-27.

Support for new claim 39 may be found in the specification at page 25, lines 24-28.

Support for new claim 40 may be found in the specification at page 29, lines 19-21.

The only remaining rejection and objection to the subject application are directed to bringing the specification in harmony with the allowed claims and a double patenting rejection.

In response to the objection by the Patent Office to the specification because the Summary of the Invention contains a disclosure outside the bounds of the claims being examined, Applicants have amended the brief summary of the invention and restricted the descriptive matter so as to be in harmony with the soon to be allowed claims (MPEP §1302.01). Accordingly, the objection has been overcome.

The Patent Office rejected claims 29 and 30 under the judicially created doctrine of double patenting as allegedly unpatentable over: claims 3-4 of U.S. Patent No. 5,885,796; claims 1-6 of U.S. Patent No. 5,851,795; and claims 1-2 of U.S. Patent No. 5,844,095.

U.S. Patent Nos. 5,844,095; 5,851,795 and 5,885,796 and the subject application are all owned by Bristol-Myers Squibb Company. As such, Applicants provide a Terminal Disclaimer executed by Ms. Briana C. Bergen, Senior Counsel, Biotechnology Patents, Bristol-Myers Squibb Company (annexed hereto as Exhibit 1). Applicants also enclose a check including the amount of \$130.00 under 37 C.F.R. §1.20(d) to cover the filing of the terminal disclaimer.

In the enclosed Terminal Disclaimer, Ms. Bergen states that Bristol-Myers Squibb Company is the owner of all right, title and interest in the above-identified application, and it disclaims the terminal part of any patent granted in this application which would extend beyond the expiration date of U.S. Patent Nos. 5,844,095 issued December 1, 1998; 5,851,795 issued December 22, 1998 and 5,885,796 issued March 23, 1999.

Further, Bristol-Myers Squibb Company agree that any patent granted on the above-identified application shall be enforceable only for and during such period that the legal title to such patent shall be the same as the legal title to U.S. Patent Nos. 5,844,095 issued December 1, 1998; 5,851,795 issued December 22, 1998 and 5,885,796 issued March 23, 1999.

Additionally, in accord with the rules, Applicants provide a Written Consent of Assignee under 37 C.F.R. §3.73(b) establishing the right of Bristol-Myers Squibb Company as assignee to take action (annexed hereto as Exhibit 2) including copies of all assignments for the inventors of the claims of the subject application (with the exception of Dr. Ledbetter) to Bristol-Myers Squibb Company (Exhibit 2D).

Further, since in the subject application, unlike all remaining co-inventors, Dr. Ledbetter refuses to execute an Assignment of Rights in the subject application to Bristol-Myers Squibb Company, in accordance with the requirements under 37 C.F.R. §1.183, Applicants provide:

1. a Petition under 37 C.F.R. §1.183 to suspend the rules regarding 37 C.F.R. §3.73(b) that ownership be established by documentary evidence of a chain of title from the original inventor to assignee in the subject application and to accept the attached Written Consent of Assignee under 37 C.F.R. §3.73(b) ("Rule 73(b)") despite the lack of an executed assignment from Dr. Ledbetter to Bristol-Myers Squibb Company (Exhibit 3) in the subject application; and
2. A fee of \$130.00 under 37 C.F.R. §1.17(i).

In view of the Terminal Disclaimer, Applicants request that the Patent Office reconsider and withdraw the rejection of obviousness-type double patenting.

CHANGE OF INVENTORSHIP

Applicants submit a Request to Correct the Inventorship in the above-identified patent application under 37 C.F.R. §1.48(a) (Exhibit 4A).

The inventive entity, Peter S. Linsley, Jeffrey Ledbetter, Jurgen Bajorath, Robert Peach, William Brady, Philip Wallace, and Nitin Damle, is set forth, in error, in the executed Declaration Under 37 C.F.R. §1.63, filed on February 28, 2001, with the U.S. Patent and Trademark Office, in connection with the above-referenced application. This inadvertent error arose without any deceptive intent by the named inventors.

Peter S. Linsley, Jeffrey Ledbetter, Jurgen Bajorath, Robert Peach, William Brady, Philip Wallace, and Nitin Damle, were originally named as the inventors of the originally filed claims of the subject application.

The subject application was originally filed with claims 1-25. As part of a response to a restriction requirement, Applicants added (a) claims 26-28, on June 2, 2004; and (b) claims 29-30, on August 2, 2004. Further, on August 2, 2004, Applicants elected, with traverse, the invention of claims 29-30 for prosecution on the record. Claims 1-2, 5, 9 and 11-30 are pending, although only claims 29-30 are being examined.

Upon review, Philip Wallace is not an inventor of the originally filed claims 1-25 (which are deemed withdrawn but currently pending), later filed claims 26-28 (which are deemed withdrawn but currently pending), or later filed and elected, pending claims 29-30.

Therefore, Applicants respectfully request that Philip Wallace be removed as an inventor of the pending claims of the subject application.

The correct inventive entity of the originally filed claims of the subject application is Peter S. Linsley, Jeffrey Ledbetter, Jurgen Bajorath, Robert Peach, William Brady, and Nitin Damle.

In accordance with 37 C.F.R. §1.48(a), in addition to this Request, Applicants also submit:

1. A Declaration from Dr. Philip Wallace, who is being deleted as an inventor and stating that the error in inventorship occurred without deceptive intention on his part (Exhibit 4B);
2. Declarations under 37 C.F.R. §1.63 executed by the actual inventors except for inventor Ledbetter (Exhibit 4C);
3. A copy of a Written Consent of Assignee (Exhibit 2); and
4. A fee of \$130.00 under 37 C.F.R. §1.17(i).

Since Dr. Ledbetter refuses to sign the Declaration under 37 C.F.R. §1.63, in accordance with the requirements under 37 C.F.R. §1.43(a)(3), Applicants provide the following:

1. Petition Under 37 C.F.R. §1.47(a) (Exhibit 5A);
2. Copies of Combined Declarations and Powers of Attorney under 37 C.F.R. §1.63 executed by co-inventors Peter S. Linsley, Jurgen Bajorath, Robert J. Peach, William Brady and Nitin Damle (Exhibit 5B);
3. Copy of a letter sent to the last known address of a non-signing inventor, Jeffrey A. Ledbetter, including enclosures: (1) an original Combined Declaration and Power of Attorney; (2) copy of amendments filed with the application; (3) copy of the originally filed patent application; and (4) copy of pending claims 1-2, 5, 9, 11-30 (Exhibit 5C); and

4. Copy of the Federal Express email confirmation and delivery information indicating that the letter was signed for in behalf of Jeffrey A. Ledbetter (Exhibit 5D); and
5. A fee of \$130.00 under 37 C.F.R. §1.17(h).

Additionally, Applicants wish to note that this Petition under 37 C.F.R. §1.47(a) is the second such Petition being filed. The first Petition under 37 C.F.R. §1.47(a) was filed in the subject application on February 28, 2001 and submitted for reconsideration on November 5, 2001 (although date-stamped received by the Patent Office on January 4, 2002) because at that time, Dr. Ledbetter also refused to sign the Declaration under 37 C.F.R. §1.63 as part of the originally filed subject nonprovisional application. The Patent Office granted Applicants' earlier filed Petition under 37 C.F.R. §1.47(a), and for convenience, copies of the Decision Granting Status Under 37 C.F.R. §1.47(a) and a letter from the U.S. Patent Office addressed to inventor Ledbetter, both dated January 25, 2002 are attached (Exhibit 5E).

Applicants submit a check to include the amount of \$970.00 to cover the following:

- (a) fee of \$130.00 under 37 C.F.R. §1.20(d) in connection with 37 C.F.R. §1.321;
- (b) fee of \$130.00 under 37 C.F.R. §1.17(h) in connection with 37 C.F.R. §1.183;
- (c) fee of \$130.00 under 37 C.F.R. §1.17(i) in connection with 37 C.F.R. §1.48(a); and
- (d) fee of \$130.00 under 37 C.F.R. §1.17(h) in connection with 37 C.F.R. §1.47(a).
- (e) fee of \$450.00 under 37 C.F.R. §1.17(a)(2) for Two Month Extension of Time

CONCLUSION

Entry of this Amendment and the foregoing remarks are respectfully requested. Applicants believe that all grounds for rejection of the claims have been overcome and that claims 29-40 are now in condition for allowance. Withdrawal of the Patent Office's rejections is requested and prompt allowance of the claims is solicited. If any issues remain in connection with the claim, the Examiner is encouraged to contact the undersigned by telephone to discuss the same.

No fees other than those listed in the accompanying transmittal sheets are deemed necessary in connection with the filing of this Amendment. If any additional fee is necessary, the Patent Office is authorized to charge any additional fee to Deposit Account No. 50-0306.

Respectfully submitted,



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